

PATENT**C. REMARKS****1. Status of the Claims**

Claims 1-20 are currently present in the Application and stand rejected. Claims 1, 8, and 14 are independent claims and have each been amended to correct a minor drafting issue noticed by Applicants. No claims have been cancelled, or added in this Response.

2. Drawings

In the First Response (March 11, 2004) Applicants noted that the Examiner did not indicate whether the formal drawings, filed by Applicants with the Application, were accepted by the Examiner. Applicants note that the Examiner has not indicated whether the drawings are acceptable in the present Office Action. Applicants respectfully request that the Examiner indicate whether the drawings are accepted.

3. Claim Rejections - 35 U.S.C. § 103 - Alleged Obviousness

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being allegedly obvious and therefore unpatentable over Cafolla et al. in Oracle Human Resources North American User's Guide, Release 11, Vol. 1, March 1998 (hereinafter "Cafolla") in view of U.S. Patent 6,236,996 to Bapat et al. (hereinafter "Bapat"). Applicants respectfully traverse the rejections.

As an initial matter, in the First Office Action (Dec. 19, 2003), the Examiner used Cafolla as the sole § 102 reference and Applicants overcame the rejections contained in the First Office Action and explained that Cafolla fell far short of teaching

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Applicants' claimed invention. Applicants pointed out that while Cafolla is an extensive, 908 page, user manual of a human resources system it fails to teach or suggest Applicants' claimed invention. In Applicants' prior Response, Applicants overcame the rejections in the First Office Action by emphasizing that Cafolla fell far short of teaching or suggesting Applicants' claimed invention.

In the present Office Action, the Examiner uses most of the same arguments that Applicant believes were overcome from the First Office Action. However, as will be described in detail below, the present Office Action uses a second reference (Bapat) to allege that Applicants' claimed invention is now obvious in light of Cafolla in view of Bapat. Applicants believe that Applicants' claims have been misunderstood or misconstrued in the present Office Action. In addition, Applicants respectfully submit, as detailed below, that the teachings of Cafolla and Bapat have been misapplied in rejecting Applicants' claims.

As described in further detail below, Cafolla fails to teach or suggest Applicants' claims. The addition of the Bapat reference, as explained below, does not overcome the deficiencies of Cafolla when comparing Applicants' claim limitations with the cited sections of Cafolla and Bapat.

Each of Applicants' independent claims include the limitations of selectively displaying employee profiles comprising the steps of:

- selecting one or more employees to exclude from a first view, the first view including employee profile information corresponding to a plurality of employees;

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- excluding the employee profile information corresponding to the selected employees from the first view, the exclusion resulting in a second view; and
- granting view access to the second view to one or more of the selected employees.

Regarding the first limitation, "selecting one or more employees to exclude from a first view, the first view including employee profile information corresponding to a plurality of employees," the present Office Action submits that Cafolla teaches "the first view including employee profile information corresponding to a plurality of employees." However, Applicants respectfully note that this is not the limitation claimed by Applicants. Rather, Applicants claim "selecting one or more employees to exclude from a first view, ..." The present Office Action omits the first part of Applicants' first limitation. Because Cafolla does not teach or suggest "excluding employees" from any views, Cafolla also does not teach or suggest "selecting" such employees. The present Office Action asserts that Cafolla teaches "using people folder as the first view to find people of interest." However, Applicants respectfully note that Applicants do not claim "finding people of interest," instead, Applicants claim "selecting employees to exclude..." This is the opposite of what is taught by Cafolla. Cafolla teaches "finding people of interest" in order to view more information on such people. In stark contrast, Applicants are claiming selecting employees to "exclude" so that the excluded employees' information does not appear on the second view. Applicants respectfully submit that the above claim elements have been overlooked in the present Office Action.

Unlike the First Office Action, the present Office Action admits that "Cafolla does not specifically teach excluding rows

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from a first view to directly create a second view," but the present Office Action contends that "Cafolla teaches creating a new window from an existing first view," citing Page 8-24 of Cafolla that displays "a payroll batch window and selecting 'defaults' to display a second window at Page 8-25. Applicants actual claim limitation is "excluding the employee profile information corresponding to the selected information from the first view, the exclusion resulting in a second view" and not simply "excluding rows from a first view to directly create a second view," as the present Office Action contends. Applicants respectfully submit that these claim limitations also appear to have been overlooked in the present Office Action.

The present Office Action states that, "However, Cafolla teaches entering additional query criteria to create new view as desired at Pages 7-45 and 7-46." As noted above, Applicants create a new (second) view by "excluding" employees selected from a first view. Applicants respectfully submit that this is entirely different from "entering query criteria" to create a new view, as taught by Cafolla. On pages 7-45 and 7-46, Cafolla teaches "selecting elements" and does not teach or suggest selecting employees to include in the query. Applicants respectfully submit that, not only does Cafolla not teach or suggest "excluding" employees from a view, Cafolla also does not teach or suggest "selecting" employees. Instead, a careful reading of Cafolla shows that Cafolla teaches selecting "elements" that apply to one or more employees.

Applicants also point out that on 7-45 and 7-46, Cafolla is using a "window" to display data and is not using a database "view," as taught by Applicants. This distinction is important because users cannot be granted "view access" to a "window" as

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described by Cafolla. Instead, the granting of access to a view is performed using a database "view" as claimed by Applicants. Therefore, combining Cafolla's "window" with art, such as Bapat, that teaches granting access to a database view, simply will not work because the database "grant" simply will not work in conjunction with Cafolla's "window."

The present Office Action states:

It would have been obvious to one having ordinary skill in the art at the time of [sic] the applicant's [sic] invention was made to combine the teaching of creating new window [sic] from existing window, and creating new view based upon additional query criteria from the Cafolla reference by using the new query criteria to exclude records as selected from a first view to generate a second view because an [sic] ordinary skilled in the art who could create views would have known that view can be used to hide or include some rows from user(s) through implementation of a where clause in a SQL statement. Furthermore, creating a narrower view from a broader view is a common daily routine to [sic] ordinary skilled in the art, for example, hiding some icons on PC monitor, opening portion of file directories and narrowing down context searches of documents. This practices [sic] all have something in common: excluding some records from a first view to result in a narrower second view.

Applicants assert that the only way one of ordinary skill in the art would contemplate performing all of the steps outlined by the Examiner in the portion of the Office Action recited above is with benefit of Applicants' disclosure. Given the length of what the present Office Action assumes to be "obvious," Applicants respectfully assert that it would not be obvious to one of ordinary skill without benefit of Applicants' disclosure. In addition, Applicants submit that the above-referenced portion of the present Office Action overlooks the

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actual claim elements found in Applicants' claims, as explained below.

First, Applicants respectfully submit that the Examiner mixes the terms "window" and "view" in the rejection. As discussed above, Cafolla teaches the use of "windows" and Applicants teach and claim a first and second "view." This distinction is important as Applicants have pointed out that access can be granted to a database "view" but cannot be granted to a "window." Nowhere does Cafolla teach or suggest creating a database "view" out of the data displayed in Cafolla's "window" taught on pages 7-45 and 7-46. In addition, Applicants claimed invention selects "one or more employees" from a first view with the employee profile information corresponding to the selected employees being excluded from a first view, and then view access is granted to the excluded employees. Applicants respectfully submit that the present Office Action appears to overlook this aspect of Applicants' claimed invention in applying the references. Applicants are concerned that the Examiner, in rejecting Applicants' claims, has viewed Applicants' claimed invention as an invention that only deals with performing simple database queries based upon generic "rows" of data. As pointed out above, Applicants' claimed invention performs specific actions using specific elements. Applicants respectfully submit that neither Cafolla nor Bapat teach or suggest performing these actions on these elements.

Second, the cited section from the present Office Action equates Applicants' claimed invention of "selecting one or more employees to exclude from a first view ... excluding the employee profile information corresponding to the selected employees from a first view resulting in a second view ... and granting the

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selected employees view access to the second view" as synonymous with "hiding some icons on a PC monitor, opening portion of file directories and narrowing down context searches of documents." Applicants respectfully fail to see the relevance of hiding icons, opening files, and narrowing context searches with Applicants claimed invention.

And third, the above-cited section of the Office Action fails to note the fact that Applicants claim both "excludes ... information corresponding to the selected employees" as well as granting those same excluded employees "view access" to the resulting second view. Applicants respectfully submit that in order to establish a *prima facie* case of obviousness, "all claim limitations must be taught or suggested." MPEP 2143.03 states:

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants respectfully submit, as evidenced above, the present Office Action fails to give consideration to all of Applicants' claim limitations. The Office Action fails to examine the Applicants' actually filed claims, as outlined above.

Unlike the First Office Action, the present Office Action admits that Cafolla does not teach or suggest "granting view access to the second view to one or more of the selected employees." However, Cafolla fails to teach or suggest this

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limitation at Page 34-15 at the paragraph beginning with "ROLEGEN." While the ROLEGEN paragraph of Cafolla does teach granting database permissions, it does not teach that permissions are granted to any views that resulted from selecting employees to exclude from such views. Moreover, this section of Cafolla does not teach or suggest granting permission of such views to "the selected employees," as claimed by Applicants. Note that in Applicants' claims, the "selected employees" are the employees whose information has been excluded from the second view. Furthermore, Cafolla is not teaching or suggesting the performance of an "exclude" function prior to granting permissions to the tables.

To shore up this deficiency of Cafolla, the present Office Action alleges that Bapat teaches "granting query on a view to user(s)," citing col. 22, lines 1-22 of Bapat. Applicants respectfully disagree.

Column 22, lines 1-22 of Bapat are as follows:

After creating a View, the Create_View procedure 362 grants the user for whom the View was created permission to use it. For example, the SQL command for granting permission to use a View may look like:

Format of Grant command:

GRANT privilege type ON view_name TO user

Example of Grant Command:

GRANT SELECT ON view_Table1_scott TO scott.

After executing this GRANT statement, the system administrator, a user named "scott" can utilize the View named "view_Table1_scott."

In an alternative embodiment, a single View can be created to access management information stored in multiple tables. Alternatively, a single View can be created and access to the View can be granted to a group of users who are all members of a group having a group name, either using a

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group grant command or by executing one or more Grant commands listing multiple users.

While Bapat does teach granting access to a user or number of users, Bapat does not teach or suggest creating the view to which access is granted in any way similar to that taught and claimed by Applicants. Instead, Bapat teaches a "Create_View" procedure that converts a user-TargetMap for a user-table pair into a "Create View" SQL command (col. 21, lines 12-16). Bapat teaches selecting database rows for the resulting views using a "fully distinguished name (FDN)" that corresponds to a "managed object." Nowhere does Bapat teach or suggest granting users (employees) access to a view after excluding data corresponding to such users (employees) from the view.

In short, Cafolla in view of Bapat completely fail to teach or suggest any of the limitations set forth in Applicants' independent claims. The combination of Bapat to Cafolla in the present Office Action does not overcome this failure. In order for Applicants' claims to be anticipated, each and every element of Applicants' claims must be found in the references. In Applicants' prior Response, Applicants stated:

Because of Cafolla's complete failure to teach any of Applicants' claimed limitations, using the Cafolla reference in a subsequent rejection under 35 U.S.C. § 103 would likely be improper as there would likely be no reason (motivation) for the references to be combined without the use of impermissible hindsight using Applicants' claims as guideposts.

Applicants' respectfully submit that there is simply no motivation, found in the prior art, to combine the human resource system taught by Cafolla with the database system of Bapat that teaches using "fully distinguished name (FDN)" that corresponds to a "managed object" to create views to which

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access is granted to users. Instead, Applicants respectfully submit that the present Office Action improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the present Office Action used impermissible hindsight in combining Cafolla and Bapat in order to support a rejection of Applicant's claims.

MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the

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claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicants asserts that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Office Action fails to explain how combining the "windows" taught by Cafolla's human resource system with Bapat's teaching of selecting database rows

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for the resulting views using a "fully distinguished name (FDN)" that corresponds to a "managed object" would result in a workable solution. Applicants have pointed out that this combination is not a workable solution because the Database Management System (DBMS) used by Bapat would be unable to grant view access to the "window" taught by Cafolla. Thus, Applicants contend that the Office Action used impermissible hindsight in rejecting Applicants' claims and the resulting combination is not a workable solution.

Conclusion

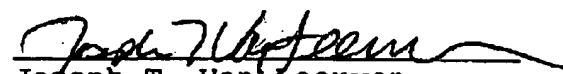
In short, Cafolla in view of Bapat completely fails to teach or suggest any of the limitations set forth in Applicants' independent claims. In order for Applicants' claims to be obvious, each and every element of Applicants' claims must be found in the references, motivation to combine the references must be found in the references themselves, and the combination of the references must result in a workable solution. Cafolla in view of Bapat fails each and every one of these requirements.

As set forth above, Applicants respectfully submit that the rejection of Applicants' independent claims 1, 8, and 14 has been traversed. Claims 2-7, 9-13, and 15-20 depend, directly or indirectly, on claims 1, 8, and 14, respectively. Therefore, claims 2-7, 9-13, and 15-20 are allowable for at least the same reasons as the independent claims are allowable. An early allowance of claims 1-20 is therefore respectfully requested. Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

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Respectfully submitted,

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